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In the Supreme Court of the United States

OCTOBER TERM—1949.

No. 331.

BERNARD EDWARD CO.,
Petitioner,

vs.

DOUGLASS R. FALKENBERG,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI.

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QUESTIONS PRESENTED.

The questions presented in the petition are:

I. Misuse of the patent in suit.

II. Contributory infringement.

III. The rule of law as to invention as defined in the "Cuno" case.

On the authority of *General Talking Picture Corp. v. Western Electric Co.*, 304 U. S. 175, only the questions presented in the petition will be considered by this Court on a petition for writ of certiorari.

ARGUMENT.

FIRST QUESTION.

Misuse of the Patent in Suit.

Petitioner in support of the first question cites:

Mercoid Corporation v. Mid-Continent Investment Co., et al., 320 U. S. 661;

Mercoid Corp. v. Minneapolis Honeywell Regulator Co., 320 U. S. 680;

Keystone Driller Co. v. General Excavator Co., 290 U. S. 240;

Precision Instrument Mfg. Co. et al. v. Automatic Maintenance Machinery Co., 324 U. S. 806,

and poses the query as to whether the Anti-Trust laws are violated *per se*.

In the case at bar, petitioner argues that Claim 15 of the patent in suit (R. pp. 24, 119), includes "a support," which is the window frame, in addition to the elements of a drapery hanger, but concedes that Claim 14 is a claim on the mounting or hanger *per se*. (Brief, p. 13.) Petitioner further argues that respondent, being in the business of manufacturing the hangers *per se*, is utilizing a combination claim to control his business in hangers *per se* and that such action amounts to an illegal extension of the patent monopoly and is measured by the Anti-Trust laws. (Brief, p. 14.)

The argument utilizing an alleged misuse of the patent in suit as a defense under the Anti-Trust laws originated in petitioner's brief before the District Court. That defense, however, was not pleaded, nor was any proof offered in support of it. No cross appeal was taken on that point, but nevertheless it was again argued in petitioner's brief before the Court of Appeals. The opinion of the District Court (R. p. 107) does not specifically refer to the defense of violation of the Anti-Trust laws, but the Appellate Court held (Rec., p. 160):

> "The defense of misuse is not sustained because no evidence was presented to prove plaintiff used his patent to secure a monopoly beyond the scope of his grant."

The Court of Appeals stated (R. p. 159) that it had difficulty in following petitioner's reasoning since at one place petitioner seemed to refer to the window frame as the unpatented part, but later specifically mentioned the bracket as the unpatented part. The Appellate Court

particularly called attention to the fact that the bracket referred to in Claim 15 is a patented article and that in use the bracket has to be attached to some kind of a support. The Appellate Court further asserted that no evidence was offered to suggest that respondent sought to have his bracket used as a tie-up with any particular brand or type of window frame, or otherwise sought to enlarge the monopoly given to him. The Appellate Court distinguished the circumstances of the case at bar specifically from the *Mercoid* and *Sylvania* cases upon which petitioner is now relying.

The case of *Keystone Driller Co. v. General Excavator Co.*, 290 U. S. 240, is one wherein the doctrine of unclean hands was held to preclude a patent owner from obtaining relief in a court of equity but in that case the patent owner was found to have suppressed evidence as to a prior public use.

In the case at bar, there is not a scintilla of evidence which would support an allegation of respondent coming into court with unclean hands.

The answer to petitioner's unsupported argument is that, if respondent had elected to rely only on Claim 14, then obviously the merits of Claim 15 would not be open for discussion. Respondent's action in relying upon claim 15 as well as Claim 14 was bottomed upon the fact, amply shown by the record, that petitioner has been practicing the combination of Claim 15 by the illustrations and instructions in its circulars, Pltf. Exhibit 3 (R. pp. 17, 97), packaged with its pair of hangers. That circular shows hangers mounted upon the upper corners of a window frame and additionally shows the drapery material positioned in the respective slots of the hangers so as to produce the valance festooning depicted on the cover page of the circular. The instructions in Exhibit 3 are ample, and it is respectfully urged that it is not beyond the bounds, within which judicial notice may be taken, to conclude that petitioner's salesmen followed the normal practice of mounting hangers upon sample boards or other supports and thread-

ing the drapery material therethrough and producing the festooned valance thereon, in display rooms of jobbers and retail stores in which petitioner's hangers were sold. Petitioner, therefore, in selling its hangers taught the practice of the entire combination of Claim 15 and may not escape the penalty of its infringement of Claim 14 by alleging that respondent's action respecting Claim 15 amounted to "unclean hands." Petitioner is attempting to achieve indirectly what it has been prevented from doing directly.

In the *Mercoid* cases, 320 U. S. 661, 680, the patent owner was obtaining royalties based only upon sales by a licensee of an *unpatented* stoker switch and granted the right to use a system which was patented only when such unpatented switches of the licensee were purchased from it and used in the system. In the case at bar, the hanger is a patented article, and respondent is not attempting by license to force anyone to purchase an unpatented part. Respondent is merely making, and selling through an exclusive distributor, a patented article. This is within the purview of the limited privilege which is inherent in the grant of a patent.

The existence of a valid claim covering respondent's hanger distinguishes the case at bar from all cases cited by petitioner in support of its allegation of misuse. Parenthetically, it is noted that in some of the cases cited by petitioner, particularly *International Salt Co., Inc. v. United States,* 332 U. S. 392, the element of price fixing was a material consideration, which situation is not an issue in this action.

The reasons assigned in the petition for the writ assert that the decision of the Court of Appeals is in conflict with applicable decisions of this Court and with decisions of other courts of appeal and then asserts (Brief, p. 8) that this Court has never passed upon the question "of a patentee having one claim of a patent which is misused to extend the monopoly of the patent and the effect thereof on the enforcement of the remaining claims of the patent."

This latter statement begs the question since it assumes misuse from the facts and circumstances of the case at bar. Furthermore, if this question has not been passed upon in any case by this Court, the holding of the Court of Appeals most certainly is not in conflict with any previous decision of this Court.

Under the heading "EACH PATENT CLAIM IS A SEPARATE MONOPOLY" petitioner (Brief, p. 19) cites *Ethyl Gasoline Corp. et al. v. United States*, 309 U. S. 436, 459, and in an excerpt therefrom quotes a statement to the effect that the patent monopoly of one invention may not be enlarged for the exploitation of the monopoly of another not embraced in the first.

Thus, at page 456, the Court in the *Ethyl* case stated:

> "He may not, by virtue of his patent, condition his license so as to tie to the use of the patented device or process the use of other devices, processes or materials which lie outside of the monopoly of the patent licensed * * * or condition the license so as to control conduct by the licensee not embraced in the patent monopoly * * * or upon the maintenance of resale prices by the purchaser of the patented article."
>
> * * * * *
>
> (457)
>
> "The picture here revealed is not that of a patentee exercising its rights to refuse to sell or to permit his licensee to sell the patented products to price-cutters. * * * A very different scene is depicted by the record. It is one in which appellant has established the marketing of the patented fuel in vast amounts on a nation-wide scale through the 11,000 jobbers and at the same time, by the leverage of its licensing contracts resting on the fulcrum of its patents, it has built up a combination capable of use, and actually used, as a means of controlling jobbers prices and suppressing competition among them."

It appears to respondent that the *Ethyl Gasoline* case might be authority only (in a hypothetical case) for restricting the right of respondent from selling his patented

drapery hangers on condition that they be used only on a certain type of window frame, also patented to respondent and not embraced by the hanger patent. The *Ethyl* case is not authority for the proposition that a licensee's sale of hangers, which are patented in themselves and are designed for use on a support that necessarily complements the hangers to produce the valance festooning, is misuse of the patent, when the further facts are that the combination of support and hangers is also patented as a drapery mounting for selective decorative draping, that neither respondent nor his licensee has any dealings in, or exercises any control over, any type of support, and that petitioner, an alleged infringer of the patented hanger, is sued both for direct and for contributory infringement. There is not a shadow of any evidence that respondent is endeavoring to control the sale of anything other than his patented hangers.

The case of *Sanitary District of Chicago v. Activated Sludge, Inc.*, 90 F. (2) 727 (C. A. 7th), is not helpful in determining the issue for that case merely reiterates the well established rule that each claim of a patent must be considered by itself, both with respect to validity and infringement. Both tribunals herein, however, have held that each of the claims in suit has been infringed, and also is valid, unless the *Cuno* case, as was interpreted by the trial Court, added an additional test of invention to the well known test of more ingenuity than the skill of the calling.

Petitioner is arguing the question of contributory infringement under a heading of so-called misuse of the patent and a course of action upon the part of respondent contrary to the Anti-Trust laws, and his reasoning is tantamount to an assertion that there is no residuum left to the doctrine of contributory infringement. Respondent's position regarding the present status of the contributory infringement doctrine will be hereinafter presented under the question of "Contributory Infringement."

The *Mercoid* decision broadened the previous doctrine to include *un*patented devices which were a part of the patented whole. Now, petitioner would further broaden the doctrine to include *patented* articles which are a part of the patented whole, for, as stated by the Court of Appeals (Rec., pp. 159-160): "the bracket referred to in Claim 15 is a patented article."

Petitioner has attempted to apply the Mercoid facts to the case at bar (Brief, p. 20) by inserting allegedly comparable parts of respondent's structure to those in the *Mercoid* case. In doing so, petitioner is comparing patented parts of respondent's structure with unpatented parts of the patent involved in the *Mercoid* case. The facts are that in the *Mercoid* case there was a tie-up in the method of licensing the unpatented switch, to make up a patented system used in the operation of a furnace.

Petitioner now seeks to substitute for the unpatented switch of the *Mercoid* case a patented hanger of the case at bar and reach the same conclusion of misuse. The fallacy, therefore, of petitioner's entire argument is that in the *Mercoid* case the Court was dealing with an unpatented part as a controlling element, whereas, in the case at bar, the alleged corresponding element is patented and the claim thereon is valid *per se*. Nothing is stated in the *Mercoid* case to the effect that the entire consideration of the matter of misuse is based on only one claim of a patent, or only one element of a claim, since the *Mercoid* case states: "since none of the separate elements of the combination is claimed as the invention, none of them when dealt with separately is protected by the patent monopoly."

Respondent *has a claim* to one element of his combination Claim 15.

The facts of the case at bar bring it within the doctrine of proper conduct under a patent, as set forth in *Florence Mayo Nu-Way Co. v. Hardy, et al.* (1948), 4th Cir., 168 F. (2) 778, 784-785, rather than within the doctrine of misconduct set forth in the *Mercoid* cases. In the *Florence*

Mayo case the claim at issue was a combination claim and the defendants were alleged to be guilty of contributory infringement in the manufacture and sale of tobacco curing equipment embodying the substance of the patented invention, and sold for use in tobacco curing barns in such way as to complete a combination constituting a direct infringement. *Mercoid v. Mid-Continent* case was cited in defense, but the court in distinguishing therefrom said (p. 785):

> "There is nothing to the contrary in the decision in Mercoid Corporation v. Mid-Continent Investment Co., 320 U. S. 661, 64 S. Ct. 268, 88 L. Ed. 376. That case merely applies the salutary rule that a combination patent may not be used to protect an unpatented part from competition. Nothing of that sort is involved here. What the defendants are doing is manufacturing and selling machinery with the knowledge, purpose and intent that it shall be used in a combination which will infringe. The case is one where plaintiff is using his patent not to monopolize the sale of what is not patented but to prevent defendants from aiding others to infringe what is patented. A clearer case of contributory infringement could not well be imagined than that presented by this record."

In *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 336 U. S. 271, this Court (p. 279) said:

> "Contentions are made that the patent has been abused through efforts to broaden the patent monopoly by requiring the purchase of unpatented material for use in connection with it. The trial court found, however, that the plaintiff does not impose on the licensee either as a condition of a license or otherwise any requirement, condition, agreement or understanding as to the purchase or use of unpatentable commodities and that its licensees are free to buy and use any material and equipment from any source. The court recognized that an appearance of such freedom is not conclusive if it conceals a subterfuge and that there is a real though informal restraint, but examining the conduct of the plaintiff it found no such obstacle to the main-

tenance of an action for infringement on that part of the patent which was valid. The court of appeals affirmed and we accept the conclusion of the two courts below on this branch of the case."

Petitioner's grounds for asserting misuse of respondent's patent seems to be that respondent is controlling a business limited to devices upon which he (respondent) owns a patent. It is an attack on respondent's proper execution of his legitimate business. What more warranted course of action than that could there be?

Misuse of a patent is an effort to obtain more benefit from a patent than the claimed invention warrants, namely, to step *outside the monopoly as granted by the patent*, and such misuse is shown by a course of action designed to gather such additional benefits. Not even a beginning of or any contemplation of such course of action is shown by the record in the present proceeding.

Respondent uses his patent as a monopoly *within* the grant, not for monopoly outside the grant.

SECOND QUESTION.

Contributory Infringement.

Under the heading of "Contributory Infringement" petitioner seeks to reopen the question of proofs of infringement after both lower tribunals have held that petitioner's device constitutes an infringement of both claims in suit.

The finding of infringement is a question of fact and this Court has recently affirmed its position that it will not undertake to review concurrent findings of fact in the absence of a very obvious and exceptional showing of error. *Graver Tank & Mfg. Co., Inc., et al. vs. Linde Air Products Co.*, 336 U. S. 271.

As to both claims in suit, the Appellate Court in finding infringement adopted the language of the District Court as follows (Rec. p. 158):

"It is clear from the evidence adduced that the defendant set out to, and actually did, copy the plaintiff's device. The only basic distinction between the two articles produced by the parties is that, whereas the plaintiff used the above-mentioned pin for the purpose of securing the material in the hanger, the defendant added beads or humps within the slots which acted as clamps. Such an addition, however, tends to accentuate, rather than differentiate, the copying."

The Appellate Court treated the foregoing language of the District Court as a finding of infringement. Moreover, the District Court requested that the record show an entry of actual inspection of Plaintiff's Exhibits 20 and 21. (R. pp. 37, 38, 45.)

Petitioner asserts (Brief, page 3) that the District Court made no finding of fact or conclusion of law with respect to infringement and that such action was contrary to Rule 52(a) of the Rules of Civil Procedure. Respondent disputes that assertion, because copying is infringement. Rule 52(a) permits Findings of Fact and Conclusions of Law to be included as part of the opinion or memorandum of decision, and such is the case in the document filed by the District Judge. It is entitled "Memorandum, Findings of Fact, Conclusions of Law, and Judgment."

Respondent denies right of petitioner to incorporate Chart 1 in its brief. (Opposite p. 29.) That chart is not in evidence nor is it a copy of what appears in the Berglund patent. It constitutes an imaginary and fanciful arrangement of what petitioner asserts is a disclosure of the Berglund patent. For convenience, the drawing of the Berglund patent (R. pp. 83, 134) is reproduced herein on the opposite page from which it will be observed that nothing whatsoever is shown with respect to the formation of a valance at the *top* of the window frame. Berglund appears in the record, pages 134 to 136 inclusive, wherein the bracket shown therein is mounted at the *bottom* of the window frame. As stated by the Court of Appeals (R. p. 158):

Feb. 11, 1930. J. A. BERGLUND ET AL 1,746,577

WINDOW SILL FIXTURE

Filed April 9, 1929

Fig. 1.

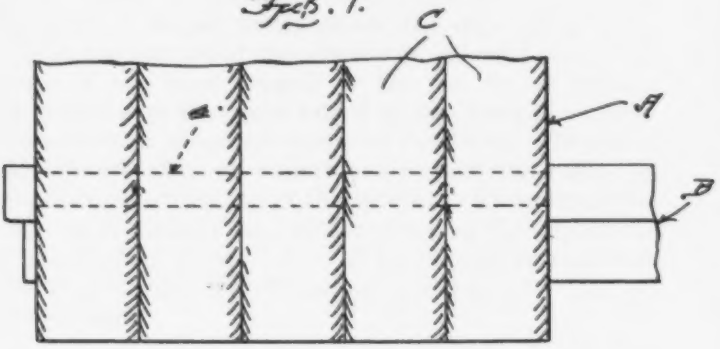


Fig. 2.

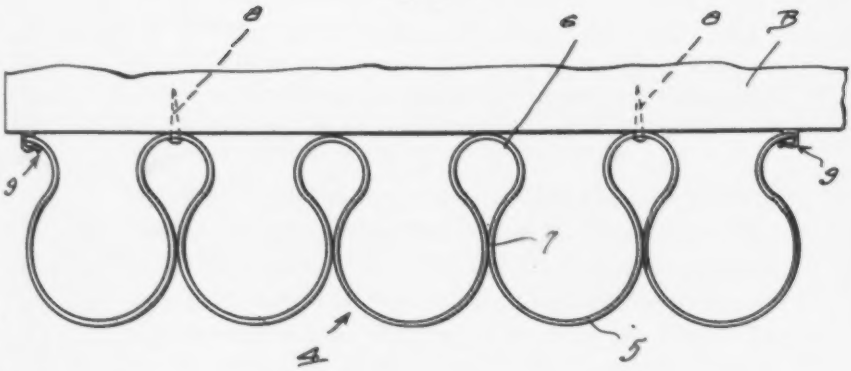
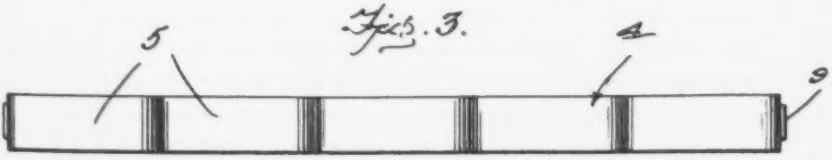


Fig. 3.



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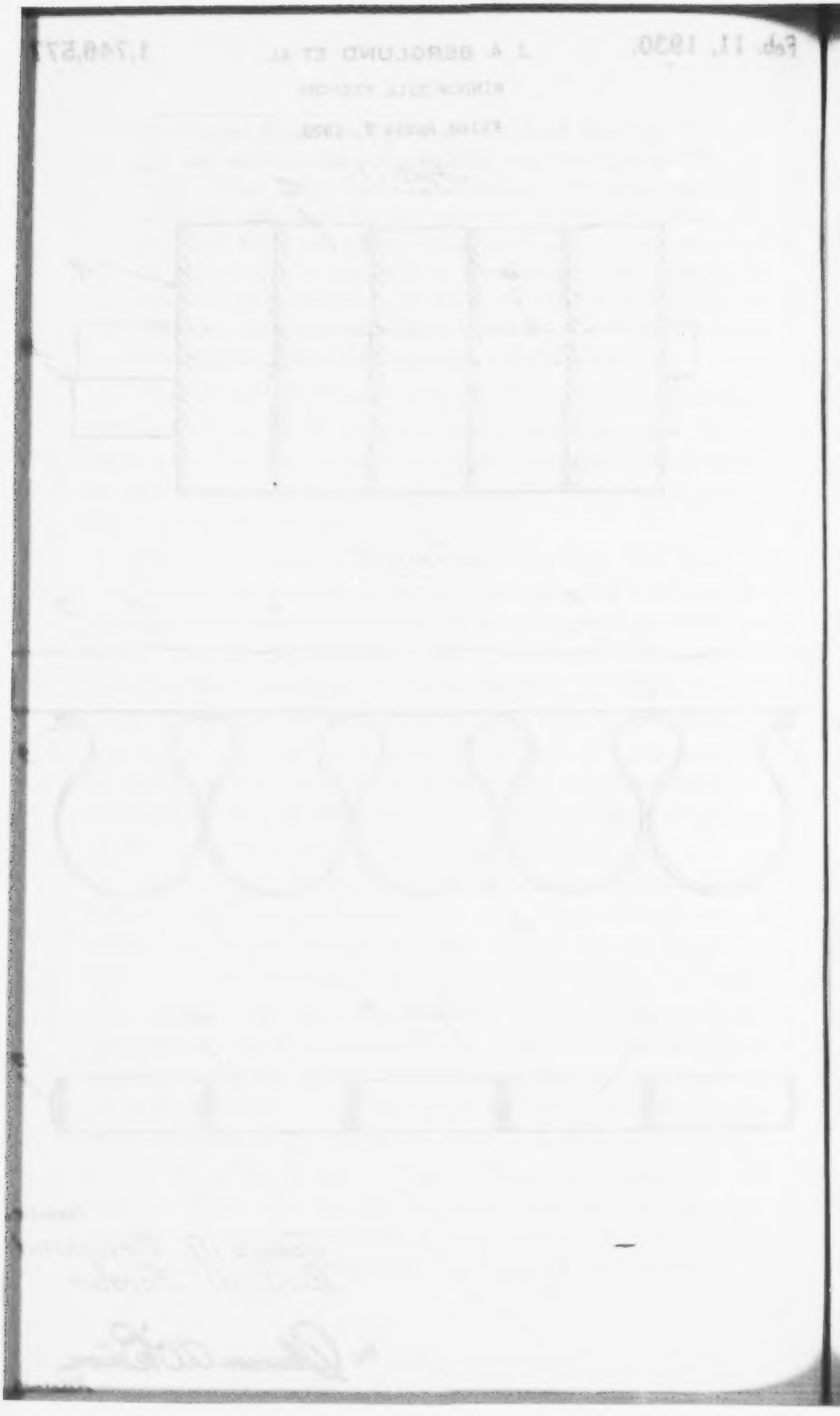

"The purpose of the device (Berglund) was to keep in place ruffling at the lower or sill level of the window. Berglund's device firmly holds the depending material at the bottom of the window in rounded formation after it has been draped at the top by an expert. Berglund says that most ruffled drapes hang in a rather disorderly or somewhat rumpled condition. He enters the picture after an expert has formed the ruffles by his draping at the top of the window. By contrast the devices of plaintiff and of defendant at the top of the window effect graceful falls of the depending material. We do not think that Berglund anticipates." (Parentheses ours.)

Berglund contemplated that the upper end of the drapery material would be hung upon an *ordinary* curtain rod, for in the specification, page 1 (Rec. p. 135), lines 7 to 11, he states:

"It is a matter of common practice in hanging window drapes and curtains to gather the upper rod suspended end in such a way as to cause the depending portion to assume a sinuously folded or ruffled state."

So far as concerns the record in this case, respondent has created a *new* valance festooning for this "sinuously folded or ruffled state," of which the bracket is an element. The only prior art in the record approaching the respondent's festooning is that illustrated at page 98, Plaintiff's Exhibit 10, offered R. p. 29, wherein the drapery material is hung loosely from the window frame behind rings. In Exhibit 13 (Rec. pp. 31, 101), an alternative arrangement shows the material drawn through the rings. Respondent's drapery mounting has achieved a new valance festooning which is not only different in appearance from Exhibits 10 and 13, but which possesses marked advantages over such mountings. Some of these advantages are set forth in detail in the opinion of the Appellate Court. (R. pp. 156, 157.)

Petitioner by virtue of its manufacture and sale of hangers and the showing in its circular, Plaintiff's Exhibit

No. 3 (R. pp. 17, 97), has infringed Claims 14 and 15 and, hence, petitioner is not justified in requesting this Court to give an advisory opinion as to petitioner's right to hang what purports to be a Berglund bracket in the manner taught by the patent in suit, nor to request a review of concurrent findings of infringement.

A particular reason for objecting additionally to petitioner's representation in Chart 1 is the fact that petitioner adduced no testimony concerning the operation of the Berglund bracket in the trial court. In the Court of Appeals petitioner produced a bracket which purportedly was made in accordance with the disclosure in the Berglund patent, but respondent entered an objection to petitioner's right to that procedure, in view of the fact that respondent was thereby denied the right of showing by expert testimony the impracticability of using the purported Berglund bracket in any place other than at the bottom of a window frame. There is no evidence whatsoever in the record to show that the Berglund bracket was suitable for use, even with modification, at the top of a window frame. One conclusion quite apparent from the sketches of petitioner's Chart 1 is that Berglund's hanger would not be suitable, since it exposes too much of the window frame to produce selective ornamental valance festooning. We assume, therefore, that this Court will not go outside the record to consider the applicability of the disclosure in the Berglund patent to the question at issue.

As stated aforesaid, it is respondent's position that Claim 15 of the patent in suit has been directly infringed by petitioner. Should this Court, however, assume that the facts and circumstances of the case at bar impel a consideration of the question of contributory infringement—notwithstanding the fact that Claim 14 is valid and infringed directly—then we respectfully direct attention to a statement by this Court in the *Mercoid* case (320 U. S. 669) as follows:

> "It is sufficient to say that in whatever posture the issue (contributory infringement) may be tendered courts of equity will withhold relief where the patentee and those claiming under him are using the patent privilege contrary to the public interest." (Parentheses ours.)

There is nothing in the record of the case at bar indicating that respondent is using his patent privilege contrary to the public interest. The circumstances are quite different from those in *Morton Salt Co. v. G. S. Suppiger Co.*, 314 U. S. 492, cited by this Court in the *Mercoid* case, for in the *Morton Salt* case, the owner of the patent was attempting to use the patent to control the sale of unpatented salt tablets.

The theory of denying relief to patent owners has been predicated upon the conclusion that a patentee has been enlarging the monopoly granted to him. But that conclusion cannot be drawn in the case at bar when the so-called unpatented bracket is in fact patented by a claim in the identical patent against which the assertion of monopoly enlargement is made.

It is false for petitioner to assert that the Appellate Court disregarded the fact that "petitioner was at most a contributory infringer of Claim 15 of the Falkenberg patent, in order to hold petitioner guilty of infringement of that claim." (Brief, p. 36.) In its brief before the Appellate Court petitioner argued the question of contributory infringement at great length. Hence, petitioner is not justified in stating that the court disregarded the question of contributory infringement. The specific absence of the word "contributory" in the decision by the Court of Appeals confirms respondent's position that defendant has by its action been a direct infringer of Claim 15.

Petitioner is Guilty of Contributory Infringement If That Is the Only Way in Which Infringement Can Be Found of Claim 15.

Petitioner's entire argument seems to be based upon the assumption that the hanger of Claim 15 is an unpatented part. That assertion, however, is directly in the teeth of the decision of the Court of Appeals which states:

"However, the bracket referred to in Claim 15 is a patented article."

Moreover, the *Mercoid* case (320 U. S. 680, 684) and particularly the excerpt appearing therefrom in petitioner's brief, page 23, was not referring to a situation where the infringer's device was covered by another claim of the patent in suit. Indeed, such point is conceded, for in its brief, page 13, petitioner states:

"Claim 14 is a claim on the mounting or hanger *per se.*"

Petitioner's assertion, in its brief at page 31, that the portions of Claim 15 which are not italicized constitute "what is sold by petitioner" is incomplete, for the italicized parts include "a pair of hangers." Respondent asserts additionally that the remaining italicized portions have a bearing on the question of infringement, for petitioner's knowledge, intent, and manner of sale, are clearly shown by the illustrations in its circular, Plaintiff's Exhibit 3 (R. pp. 17, 97).

At page 32, petitioner attempts to reopen a consideration of the file history of the patent in suit, but respondent need only point out that what appears in the file history constitutes a question of fact, and that both lower tribunals have ruled against petitioner's argument on file wrapper limitations.

At page 35, petitioner asserts that there is confusion amongst the courts regarding contributory infringement, and cites *Special Equipment v. Coe,* 324 U. S. 370, as indicating that the doctrine of contributory infringement has been completely abolished. As respondent reads the case,

however, no mention whatsoever of contributory infringement is found. The case reached this Court on a writ of certiorari granted to the Court of Appeals for the District of Columbia, which affirmed the decision of the District Court, in an action under R. S. 4915, denying petitioner's request that the Commissioner of Patents be directed to issue claims to a sub-combination, in an application renewing a forfeited application wherein claims had been allowed to a general combination, as embodied in a complete machine, of which the sub-combination constituted a part. The question was whether the Court of Appeals correctly rested its decision upon the ground that petitioner did not intend to make or use the invention. This Court, in reversing the Court of Appeals, said (p. 376):

> "Hence, denial of a patent on the sub-combination would deprive the inventor of the benefit of the exclusive right to use the sub-combination in the ways specified by the patent laws. It would also leave the public free to use, and thus to appropriate a part, however important, of the inventor's complete machine, even though patented."

In holding that the patentee was entitled to sub-combination claims, this Court approved a course of action similar to that of respondent in the case at bar, viz., obtaining claims on the sub-combination—the bracket—as well as claims to the general combination.

It is significant that the *Special Equipment* case was decided in 1945, at which time the reasoning and conclusions in the *Mercoid* cases, which were decided in 1944, were matters of then recent consideration by the Court.

Portions of two of the cases cited by petitioner as showing confusion with respect to the subject of contributory infringement are quoted as follows.

In *Sunlite Mfg. Co. v. Clarvan Corporation*, 73 F. Supp. 938, 940, cited by petitioner as indicating that the doctrine of contributory infringement is completely abolished, Judge Duffy spoke as follows:

"In view of the decision of the Supreme Court in Mercoid Corp. v. Mid-Continent Investment Co., 320 U. S. 661 (60 USPQ 21), it may well be doubted whether the doctrine of contributory infringement longer exists as an element in the patent law of this country. I am, of course, aware that some courts have attempted to limit the application of the decision in the Mercoid case to situations where patentees have extended their monopolies beyond the scope of their patents. Detroit Lubricator Co. v. Toussaint, 57 F. Supp. 837 (63 USPQ 139); Girdler Corp. v. E. I. du Pont de Nemours & Co., 56 F. Supp. 871 (62 USPQ 450); Chicago Pneumatic Tool Co. v. Hughes Tool Co., 61 F. Supp. 767 (66 USPQ 425); Hall v. Montgomery Ward & Co., 57 F. Supp. 430 (63 USPQ 114).

However, in delivering the opinion of the majority in the Mercoid case, Justice Douglas said (page 669 of 320 U. S. (60 USPQ at 25-26): 'The result of this decision, together with those which have preceded it, is to limit substantially the doctrine of contributory infringement. What residuum may be left we need not stop to consider. * * *' The language indicates that at least in the mind of the writer of the opinion, there was doubt whether any residuum existed. In Stokes & Smith Co. v. Transparent-Wrap Mach. Corp., 156 F. 2d 198, 201 (64 USPQ 278, 280 at 281), the court said in referring to the Mercoid case: '* * * Indeed, it appears from the discussion in the opinions (citing cases) that the doctrine of contributory infringement is itself not wholly free from doubt.'

However, I do not base my decision herein on whether or not contributory infringement still continues its struggle for existence. I have concluded that the claims of the patent in suit do not read upon the accused device, * * *."

In *Stroco Products, Inc. v. Mullenbach et al.*, 67 USPQ 168 (D.C.S.D. Calif. 1944), the following is noted (p. 169):

"The issue raised by the pleadings herein are by the said stipulations, interrogatories, and interrogatory answers confined to the determination of whether or not making and selling by defendants of their said con-

trol units *not covered per se by any claim in the patent in suit* constitutes contributory infringement of the claims of the patent in suit." (Italics ours.)

A detailed analysis of each case cited by the petitioner at pages 35 and 36 reveals that in no instance did the patents in suit include a claim on an element *per se*, and a combination claim including the patented element.

THIRD QUESTION.

"The Cuno Decision."

Petitioner's brief at page 37 states:

"THE COURT BELOW REJECTED THIS COURT'S 'CUNO' DECISION."

It is respondent's position that the Court of Appeals did not reject the *Cuno* decision (314 U. S. 84). It merely rejected the interpretation made by the District Court of the declaration of the law given by this Court in the *Cuno* case. The District Court thought the *Cuno* decision added to the test of invention something more than ingenuity greater than that of a worker skilled in his line of work. The District Court applied the *Cuno* case as if this Court declared that a "flash of creative genius" must be revealed in *addition* to ingenuity greater than that of a worker skilled in his line of work.

It is respondent's further position, and it has been substantiated by the Court of Appeals of the First Circuit, as well as upheld by the Seventh Circuit in the instant proceeding, that "the flash of creative genius" phrase is but another expression for that skill which is more than merely the skill of the calling. Thus, the so-called "flash of genius" test is merely another way of stating the statutory requirement of the necessity for invention or discovery, which in most cases and for the greater part of a century has been interpreted as ingenuity greater than that of a worker skilled in his line of work.

It is respectfully submitted that any difference in the application of the present state of the law regarding the

patentability of inventions and the application of the state of the law that formerly existed, is merely one of a more rigorous present standard as to what is ingenuity greater than the skill of the art, in view of the continuously increasing skill of artisans in their several lines. However, the test is, as it must be under the statute, one of whether or not the improvement in question shows more ingenuity than that of a tradesman utilizing merely the skill of his art *of his time.*

The phrase "flash of creative genius" is not an isolated instance of style of expression by the courts, for other phrases can be found throughout the decisions. For instance, in *Densmore v. William C. Schofield,* 102 U. S. 375, 378 (1880), the test is termed a "flash of thought."

In the 7th Circuit, the Court of Appeals used somewhat similar language as being synonymous with ingenuity greater than that of a worker skilled in his line of work. Thus, in *Ronning Machinery Co. v. Caterpillar Tractor Co.,* 129 F. (2) 70, 73 (1942), the court referred to the inventive act as embodying an "essential 'flash of genius' "; and in *Chicago Steel Foundry v. Burnside Steel Foundry Co.,* 132 F. (2) 812, 818 (1943), the court mentioned "flash to the mind" and " a happy thought." Indeed, this Court in the *Cuno* decision fully intended the inventive step to be only skill over and above the skill of the calling, for that decision sums up this phase of the case with the words:

> "That is to say the new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling."

The Appellate Court actually followed the ruling of this Court for it found that the respondent's invention embodied ingenuity greater than that of a worker skilled in his line of work.

See also, *Sinclair & Carroll Co., Inc. v. Interchemical Corporation* (1945) 65 Sup. Ct. 1143, 1145; 325 U. S. 327, 331, in which the *Cuno* case is cited as supporting 'he in-

terpretation of invention as "more ingenuity • • • than the work of a mechanic skilled in the art."

The phrase "flash of creative genius" has been widely misinterpreted by law writers, and occasionally by District and Appellate tribunals. Significantly, however, this Court denied certiorari in a case similar to that at bar, viz., *Brown & Sharpe Mfg. Co., et al. v. Kar Engineering Co., Inc.,* 154 F. (2) 48 (C. A. 1), certiorari denied June 10, 1946, 328 U. S. 869. In that case the District Court believed that the claims were valid, but was impelled to hold them invalid on the theory that the invention lacked a "flesh of creative genius." The Court of Appeals posed the question before it as follows:

> "The foregoing squarely presents us with the question whether the Supreme Court in the Cuno case intended to establish for the future a new and higher standard of invention than had prevailed in the past?"

Citing many cases in which the question had been considered, and quoting from several of them, the Court of Appeals, after a discussion of the term "flash of creative genius," as used in the context of the *Cuno* decision, and upon reference to later decisions of the Supreme Court in which the term was referred to, held that, in its judgment, unmistakably all that was intended in the *Cuno* case was a restatement of the classic test. Despite the earlier view of the Court of Appeals for the First Circuit that the *Cuno* case had set a higher standard of invention, it reached the conclusion in the *Brown & Sharpe* case that such earlier view was mistaken.

The denial by this Court of a petition for certiorari in the *Brown & Sharpe* case is ample precedent for the denial of a writ of certiorari in the case at bar on the THIRD QUESTION.

CONCLUSION.

Petitioner seeks to bring the facts and circumstances of this case under the Anti-Trust Laws under an allegation of misuse, but there is no evidence in this case to support any assertion of misuse. Respondent is not seeking a monopoly outside the scope of his patent, for he has a claim in the patent which covers the hanger *per se*. Such claim has been held to be valid, and infringed by petitioner.

The doctrine of contributory infringement is not applicable to petitioner for petitioner is a direct infringer of Claim 14 of the patent in suit and is likewise a direct infringer of Claim 15. Should the doctrine of contributory infringement be considered, then there is no dispute that petitioner is selling an element with the knowledge and intent that it shall be used in the patented combination.

The rule of law on invention, as defined in the *Cuno* case, has been reasserted by this Court in *Sinclair v. Interchemical,* 325 U. S. 327, and has been correctly applied by the Court of Appeals in the case at bar.

Wherefore, respondent prays that the petition be denied.

Respectfully submitted,

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